

ESTTA Tracking number: **ESTTA1182196**

Filing date: **01/03/2022**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer information

Name	McDonald's Corporation
Granted to date of previous extension	01/02/2022
Address	110 N. CARPENTER STREET CHICAGO, IL 60607 UNITED STATES
Attorney information	JOHN A. CULLIS BARNES & THORNBURG LLP ONE NORTH WACKER DRIVE SUITE 4400 CHICAGO, IL 60606 UNITED STATES Primary email: trademarks-CH@btlaw.com Secondary email(s): jcullis@btlaw.com, lee.james@btlaw.com, valerie.galassini@btlaw.com, olayeni.odumosu@btlaw.com, trademarks-CH@btlaw.com 312-357-1313
Docket no.	85529-345472

### Applicant information

Application no.	90371638	Publication date	07/06/2021
Opposition filing date	01/03/2022	Opposition period ends	01/02/2022
Applicant	Utah Home Builders Association SUITE 120 38 W. 13775 S. DRAPER, UT 84020 UNITED STATES		

### Goods/services affected by opposition

Class 036. First Use: 2020/06/01 First Use In Commerce: 2020/07/28  
All goods and services in the class are opposed, namely: Charitable fundraising

### Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

### Mark cited by opposer as basis for opposition

U.S. registration no.	1391968	Application date	08/28/1985
Register	Principal		
Registration date	04/29/1986	Foreign priority date	NONE
Word mark	THE HOUSE THAT LOVE BUILT		
Design mark			
Description of mark	NONE		
Goods/services	Class 042. First use: First Use: 1978/08/00 First Use In Commerce: 1978/08/00 PROVIDING RESIDENTIAL FACILITIES THAT SERVE AS HOMES AWAY FROM HOME FOR FAMILIES OF CHILDREN BEING TREATED FOR SERIOUS ILLNESSES		

Attachments	THE HOUSE THAT SHE BUILT Notice of Opposition.pdf(137304 bytes )
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Signature	/John A. Cullis/
Name	JOHN A. CULLIS
Date	01/03/2022

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:  
Application Serial No. 90/371,638

Published in the *Official Gazette*  
on July 6, 2021

**Mark:** The House That She Built

**Opposition No.:** \_\_\_\_\_

McDONALD'S CORPORATION,

Opposer,

v.

UTAH HOME BUILDERS  
ASSOCIATION,

Applicant.

### **NOTICE OF OPPOSITION**

Opposer, McDonald's Corporation, a corporation organized and existing under the laws of the State of Delaware, with offices at 110 N. Carpenter Street, Chicago, Illinois 60607, believes that it will be damaged by registration of the mark The House That She Built in International Class 36 as shown in Application Serial No. 90/371,638 filed by Applicant, Utah Home Builders Association, a corporation having an address at 38 W. 13775 S., Suite 120, Draper, Utah 84020, and hereby opposes the same and requests that registration to Applicant be refused.

The grounds for this Notice of Opposition are as follows:

1. Applicant is seeking to register the mark The House That She Built for “Charitable fundraising” in International Class 36. The application is based on applicant's alleged use of the mark filed under 15 U.S.C. § 1051(a).

2. This Notice of Opposition is being timely submitted.

3. Since 1955, Opposer has been in the business of developing, operating, franchising, and servicing an extensive system of restaurants that prepare, package, and sell a wide variety of high quality, quickly-prepared, modestly-priced foods. Opposer has carried on this business in the United States and throughout the world. Opposer and its subsidiaries now operate or license thousands of restaurants throughout the world, including over 14,000 restaurants in the United States.

4. Additionally, since 1978, McDonald's has used its THE HOUSE THAT LOVE BUILT mark in connection with its Ronald McDonald House Charities to promote its residential facilities that provide homes for families of children being treated for serious illnesses. The Opposer has used this phrase throughout the world to promote its charitable efforts.

5. Opposer owns U.S. Registration No. 1,391,968 for the mark THE HOUSE THAT LOVE BUILT, filed on August 28, 1985 and registered on April 29, 1986, for “Providing residential

facilities that serve as homes away from home for families of children being treated for serious illnesses” in Class 42, and Opposer has used its THE HOUSE THAT LOVE BUILT mark in connection with those services since at least as early as August 1978.

6. Through Opposer’s long, extensive, and continuous use of its THE HOUSE THAT LOVE BUILT mark, the public has come to recognize it as being uniquely associated with Opposer. Opposer has developed, at great effort and expense, exceedingly valuable goodwill with respect to its THE HOUSE THAT LOVE BUILT mark for “Providing residential facilities that serve as homes away from home for families of children being treated for serious illnesses” services.

7. Despite McDonald’s long-standing prior rights in its THE HOUSE THAT LOVE BUILT mark, Applicant began using the confusingly similar THE HOUSE THAT SHE BUILT mark in June 2020 and filed its trademark application on December 10, 2020 to register the same, Serial No. 90/371,638. Applicant’s selection of a mark that is identical, except for one word, to Opposer’s mark suggests an intent by Applicant to trade off of the goodwill and recognition associated with Opposer’s trademark.

8. Applicant’s advertising and intended use of its THE HOUSE THAT SHE BUILT mark will inevitably reach the same consumers that McDonald’s targets with its use of the well-known THE HOUSE THAT LOVE BUILT mark as both are used in connection with charitable services. Furthermore, Opposer applied to register and commenced use of the aforementioned mark in association with its designated services prior to the alleged first-use date of June 2020, as well as prior to the filing date of the subject application, December 10, 2020.

9. Consumers, upon seeing the THE HOUSE THAT SHE BUILT mark used in connection with Applicant’s charitable services, are likely to mistakenly believe that such phrase and the services provided in connection with them, originated with or in connection with, sponsored by,

associated with, or licensed or approved by McDonald's. The likelihood of such association or confusion is further heightened by the fact that the marks are nearly identical and create the same commercial impression. Thus, the registration and use by Applicant of the THE HOUSE THAT SHE BUILT mark in connection with the recited services is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

10. Issuance of a registration to Applicant for the THE HOUSE THAT SHE BUILT mark will diminish, tarnish, and dilute the distinctive quality of Opposer's rights in its THE HOUSE THAT LOVE BUILT mark and would blur and otherwise impair the distinctiveness of this mark in violation of 15 U.S.C. § 1125(c).

11. If a registration is issued to Applicant for the THE HOUSE THAT SHE BUILT mark, the confusion with McDonald's mark would result in damage and injury to McDonald's and the public. Registration of the slogan would give Applicant an unqualified right to wrongfully appropriate McDonald's goodwill and reputation associated with McDonald's mark; to benefit from the likely confusion among purchasers led to believe that Applicant's services are related in some fashion to McDonald's; and to restrict the natural growth of McDonald's THE HOUSE THAT LOVE BUILT mark.

WHEREFORE, Opposer requests that this Opposition be sustained and Application Serial No. 90/371,638 be refused registration.

The requisite filing fee of \$600.00 and any additional fees related to this matter are being charged to a credit card concurrently with this filing.

Respectfully submitted,

MCDONALD'S CORPORATION

Date: January 3, 2022

By: /John A. Cullis/

John A. Cullis

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**CERTIFICATE OF TRANSMISSION**

I hereby certify that the foregoing NOTICE OF OPPOSITION is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/> on the date noted below:

Date: January 3, 2022

By: /John A. Cullis  
One of the Attorneys for  
Opposer, McDonald's  
Corporation